

REMARKS

INTRODUCTION

In accordance with the foregoing, claims 1, 3, and 13 have been amended. No new matter has been submitted and reconsideration of the allowability of the pending claims is respectfully requested.

Claims 1, 3-7, 13, and 15 are currently pending and under consideration.

REJECTION UNDER 35 USC 112, SECOND PARAGRAPH

The Office Action indicates that independent claims 1 and 13 are unclear. In particular, the Office Action indicates that "it is unclear what condition the phrase ["so that monitor information is readable by the computer"] applies to, the on condition, the off condition or both the on and off conditions of the predetermined signal.

Here, it is believed that the Office Action's disagreement with the claim language of claims 1 and 13 can be clarified by considering the entire previously claimed: "wherein the predetermined signal is transmitted to the monitor **regardless of** whether the monitor i[s] **powered on or off** so that monitor information is readable by the computer," as recited in claim 1.

The phrase "regardless of" and "whether the monitor is powered on or off" is not indefinite. It is clear from the disclosure of the present application, and it should be clear from its ordinary use, that the recited "whether the monitor is powered on or off" is not meant to describe two different occurrences, but is meant to clarify that the predetermined signal is transmitted regardless of the state of the monitor.

As noted above, claims 1 and 13 have been amended, and currently do not set forth the previous claim language. However, claim 3 has been amended into independent form and maintains this "regardless" phrase.

In view of the above, the present application, and the common usage of the term "regardless," it is respectfully submitted that the claimed recitation is not indefinite.

Withdrawal of this rejection is respectfully requested.

REJECTION UNDER 35 USC 112, FIRST PARAGRAPH

The Office Action has further rejected the pending claims based on an interpretation of the claimed computer as always being off at the same time as the monitor is off, and the monitor always being on when the computer is on.

In particular, the Office Action recites: "[h]owever, both the claims and the specification describe that the predetermined signal indicates whether the computer is powered on or off and that the monitor receives the predetermined signal and is powered on or off according to the predetermined signal. When the predetermined signal indicates that the computer is powered on, the monitor is powered on. When the predetermined signal indicates that the computer is powered off, the monitor is powered off. The specification describes that the only time the monitor is powered off is when the computer is powered off thereby producing a predetermined signal indicating that the off state of the computer. See figure 4. Therefore, the specification describes that the computer and monitor are always powered on and off at substantially the same time. The specification is silent as to how the computer can read monitor information when it is in the off state."

Applicants respectfully disagree with this characterization of the presently claimed invention and the characterization of the detailed description.

As one example, the specification in paragraph [0038] describes the occurrence of the computer being on and the monitor being off: "Since the monitor 301 is powered off at this moment, the monitor 301 does not even operate when the video signals output from the video card 300-2 are transmitted to the monitor 301....The memory 301-1 of the monitor 301 stores monitor information concerning such things as the manufacturer of the monitor, resolution of the monitor, etc. **The predetermined signal output from the 9th pin of the video card 300-2 drives the memory 301-1 of the monitor that is currently powered off so that the memory information stored in the memory 301-1 can be read.**"

Thus, the specification explains that before the monitor may or may not be turned on, i.e., while the monitor is powered off, the predetermined signal may be used to also power the memory to read information from the memory while the monitor is powered off.

The detailed description merely provides an example of the powering up of the monitor when the predetermined signal reaches a predetermined level, e.g., 5V, but does not limit the invention to always requiring the monitor to turn on when any level of the predetermined signal is provided to the monitor.

Thus, it is respectfully submitted that the detailed description provides sufficient support for the claimed computer being on while the monitor is off, and the claimed providing of power to the memory for reading from the same when the monitor is off.

Regarding enablement, it is further noted that it is not necessary that the application describe the claim limitations exactly, but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations. In re Wertheim, 191 USPQ 90, 96 (CCPA 1976). Similarly, "[the specification] need only be reasonable with respect to the art involved; they need not inform the layman nor disclose what the skilled already posses. They need not describe the conventional... The intricacies need not be detailed ad absurdum." General Electric Co. v. Brenner, 159 USPQ 335 (D.C. Cir. 1968). In addition, a defining aspect of enablement is that there isn't undue experimentation, i.e., experiment required to reproduce the claimed features is satisfactory, as long as it isn't undue experimentation. In re Geerdes, 180 USPQ 789, 793 (CCPA 1974).

Again, an amount of experiment required to reproduce the claimed features is acceptable, as long as it isn't undue experimentation.

In addition, as noted in MPEP § 2163.04, a "description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption." The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The Examiner has the initial burden or presenting by the a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention as defined by the claims.

MPEP § 2163.04(I) further details that in rejecting a claim, "the examiner must set forth express findings of fact which support the lack of written description." As further detailed, "[t]hese findings should: (a) Identify the claim limitation at issue; and (B) Establish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as filed. A general allegation of 'unpredictability in the art' is not a sufficient reason to support a rejection for lack of adequate written description."

Further see MPEP § 2163.04(II), where the Examiner is required to "consider the record as a whole, including amendments, arguments, and any evidence submitted by applicant," before reissuing a § 112 description rejection.

Thus, in view of the above, it is respectfully submitted that the detailed description sufficiently describes and enables the presently claimed invention. Withdrawal of this rejection is respectfully requested.

REJECTION UNDER 35 USC 102

Claim 1 stand rejected under 35 USC 102 as being anticipated by Kim et al., U.S. Patent No. 5,961,647. This rejection is respectfully traversed.

The Office Action has indicated that the claimed "so that monitor information is readable by the computer," was not given any patentable weight since it was functional "and conclusory in that it recites desired results without reciting the structure required to perform the desired results."

However, as stated in the MPEP, "A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used," e.g., a functional limitation may be used to functionally define a particular capability or purpose that is served by the recited element. MPEP § 2173.05(g) ("[i]n a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said hosing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.")

Thus, any functional language in a claim under review must be considered as to how it may be further defining the structural attributes of the claimed invention.

Regardless, to further prosecution, applicants have amended independent claims 1 and 13 to set forth the claimed phrase in a different manner, while attempting to maintain substantially the same breadth.

With these amendments, independent claim 1 now recites the providing of monitor information from the monitor to the computer regardless of whether the monitor is powered on or off.

Accordingly, with the Office Action's indication in the §103 rejection of claims 3-7, 13, and 15, that Kim et al. fails to disclose at least such a feature, applicants respectfully request that this rejection be withdrawn.

REJECTION UNDER 35 USC 103

Claims 3-7, 13, and 15 stand rejected under 35 USC §103 as being obvious over Kim et al., in view of Chaiken et al., U.S. Patent No. 6,223,283. This rejection is respectfully traversed.

The Office Action has primarily relied upon Kim et al. as disclosing all the claimed features except for the claimed monitor including memory that can provide the computer with monitor information regardless of whether the monitor is on or off.

For this deficient feature, the Office Action has indicated that Chaiken et al. discloses that microcomputers within monitors typically include ROM, and based upon that disclosure it would have been obvious for Kim et al. to be modified to include such a memory.

Thereafter, as a first reason for modifying Kim et al. to separately power such a memory, the Office Action indicates that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to power the memory from the 5 volt power signal of Kim in order to provide power to the memory whether the monitor is powered on or off because this would allow the monitor to remain off during computer initialization and configuration thereby reducing the power consumed by the monitor and Kim discloses providing a separate power source to the switching circuit components (MICOMs) in the monitor making the switching circuit power independent of the monitor power supply."

As a second reason for modifying Kim et al. to separately power a memory, the Office Action indicates that it is well known in the art that microcomputers such as MICOM typically include read only memory, and that Chaiken et al. indicates that EDID information in a monitor memory is typically read out during initialization, citing col. 1, lines 45-59 of Chaiken et al.

First, regarding this latter point that Chaiken et al. indicates that EDID information is typically read out of a memory during initialization, it is respectfully submitted that this disclosure is nothing more than that disclosed in the present application as a problem with conventional systems.

In particular, the present application explained that conventionally monitors were either powered up or powered down, with selective systems within the monitors being inaccessible to a computer when powered down.

To solve this problem, embodiments of the present invention proposed to separately provide power to a memory of the monitor, regardless of whether the monitor is powered down.

The relied upon portion of Chaiken et al. does no more than further explain that when the monitor is powered up, only then could conventional computers access memories with the monitor.

Only the present application describes both the problem and a proposed solution for such a configuration by permitting the computer still access the memory of the monitor before it is powered up, which is substantially different from the disclosure of Chaiken et al.

Here, without some reason or need, and without the description of the present application, there is no disclosure in the present record making the required leap from the conventional monitors that only provide power to their memories upon startup and the claimed memories that can be powered by the computer's predetermined signal.

Regarding the Office Action's first point for modifying Kim et al., it is similarly respectfully submitted that only the present application provides any support for the proposed modification of Kim et al.

In particular, the Office Action's proposed motivation for modifying Kim et al. would **only** appear to be supported by applicants described invention.

Neither Kim et al. nor Chaiken et al. disclose or suggest modifying conventional monitor powering systems to now use the claimed predetermined signal.

As recited above, the Office Action's rationale for modifying Kim et al. would appear to be based solely on the present application's disclosed invention, including **both** the problems with conventional systems and a way of overcoming the same.

Further, the recited motivation of "because this would allow the monitor to remain off during computer initialization and configuration thereby reducing the power consumed by the monitor and Kim discloses providing a separate power source to the switching circuit components (MICOMs) in the monitor making the switching circuit power independent of the monitor power supply," would appear to be the Examiner's own conclusion and not supported by the record.

Conversely, to meet a prima facie obviousness cases, there must be **evidenced** motivation, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference. In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

MPEP § 2142 further points out that the Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.”** Dembiczak, 50 USPQ2d at 1617. “The factual inquiry whether to combine the references must be thorough and searching.” In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). **The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34.** The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

As commonly understood, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art... “[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992). In addition, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Id. at 1783-84.

Here, in the outstanding proposed modification of Kim et al., it is respectfully submitted that the outstanding Office Action has failed to point to any outside objective evidence that it would have been obvious to modify Kim et al.

The Office Action has primarily relied upon Chaiken et al. to disclose a conventional monitor with a memory, and has similarly relied upon Kim et al. to disclose a selective controlling of a powering on/off of a monitor outside of the monitor’s power supply, but has failed to provide any evidence supporting the further proposed modification of Kim et al. to now use the provided signal to also power the memory of the monitor. Only the present application provides this disclosure.

In addition, if anything, the disclosure of both Kim et al. and Chaiken et al. support the countering conclusion that conventional monitors have not previously operated as claimed, which supports a non-obviousness conclusion.

Thus, in view of the above, it is respectfully submitted that the outstanding Office Action fails to present a prima facie obviousness case.

Withdrawal of this rejection is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

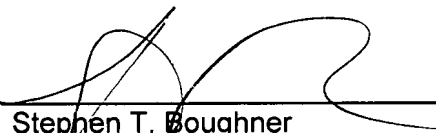
If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

In addition, if there are any additional fees associated with filing of this Preliminary Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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